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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/489,225	01/21/00	CARRIGAN	PU4355050PH1

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EXAMINER  
MEHTA, A

ART UNIT PAPER NUMBER  
1638

DATE MAILED: 07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/489,225

Applicant(s)

CARRIGAN, LORI L.

Examiner

Ashwin Mehta

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

KATRINA TURNER  
PATENT ANALYST

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Status Of The Application***

1. Examination of this application has been transferred to Examiner Ashwin Mehta. The art unit, 1638, remains the same.

#### ***Claim Rejections***

2. Claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, for the reasons of record stated in the last office action on pages 2-4 under item 2.

3. Claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention, for the reasons of record stated in the last office action on pages 4-5 under item 3.

4. Claims 11, 15, 19, 24, 28, and 32 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons of record stated in the last office action on pages 5-6 under item 4.

5. Claims 11, 15, 19, 24, 28, and 32 remain rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Luedtke, Jr. et al, for the reasons of record stated in the last office action on pages 7-8 under item 7.

***Response to Arguments***

6. Applicant's arguments filed 22 May 2001 and 18 May 2001 have been fully considered but they are not persuasive.

***35 USC § 112***

7. Applicants traverse the rejection to claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 under 35 U.S.C. 112, first paragraph. Applicants indicate that the actual ATCC deposit will be delayed until receipt of notice that the application is otherwise allowable. Applicant's intent is acknowledged. As the application is not in condition for allowance, the rejection is maintained.

8. Applicants traverse the rejection to claims 1-9, 10 (amended), 11-13, 14 (amended), 15-17, 18 (amended), 19-22, 23 (amended), 24-26, 27 (amended), 28-30, 31 (amended), and 32 under 35 U.S.C. 112, second paragraph. Applicants submit that a deposit will be delayed until notice of otherwise allowable claims as provided under 37 C.F.R. 1.809. Applicants indicate that the claims will be amended at that time to recite the accession number. As the application is not in condition for allowance, the rejection is maintained.

9. Applicants traverse the rejection to 11, 15, 19, 24, 28, and 32 under 35 U.S.C. 112, second paragraph. Applicants argue that the claims recite two requirements- that 38T27 be an ancestor of the plant and second that the claimed plant be “capable of expressing a combination of at least two 38T27 traits” selected from a Markush group. Applicants argue that the presence of “38T27” in front of “traits” indicates that the Markush listing is directed to “38T27 traits” originating from 38T27. However, none of the listed traits is unique to 38T27. That is, other plants may possess these traits. It is therefore possible that the traits listed in the Markush group may have been introduced from other plants in the claimed plants ancestry, and not from 38T27. Further, as discussed in the last office action, the claims have no limitation on the degree of relatedness of the derived plant, and encompasses plants that are vastly different from the plant taught in the specification. The rejection is maintained.

***35 USC § 102 & 103***

10. Applicants traverse the rejection to claims 11, 15, 19, 24, 28, and 32 under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious under Luedtke,

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Jr. et al. Applicants submit that the claims do not simply recite traits, but instead recite specific traits only to the extent that they are “38T27” traits. Applicants argue that the claims also recite that the plant must have 38T27 as an ancestor, and contend that the traits therefore originated from 38T27. However, the traits listed in the claims are not unique to 38T27. Other plants may possess any one or more than one of these traits. The claims do not indicate what feature of any one of these traits makes it unique only to 38T27. Further, the claims do not distinguish plants that possess at least two of the listed traits that do not have 38T27 in its ancestry from those that do. Applicants argue that one can easily tell by reference to the plant’s breeding history or its molecular profile whether the plant did indeed have 38T27 as an ancestor and expressed at least two 38T27 traits. However, the process of making the claimed plants does not distinguish the plants themselves from those taught by the reference, particularly since neither the number of other parents nor the number of generations involved in producing the plants are specified, wherein 38T27-derived genetic material is lost as the number of other parents or generations increases. See In re Thorpe, 227 USPQ 964,966 (Fed. Cir. 1985), which teaches that a product-by-process claim may be properly rejectable over prior art teaching the same product produced by a different process, if the process of making the product fails to distinguish the two products. Thus, the claimed invention was clearly prima facie obvious as a whole to one of ordinary skill in the art, if not anticipated by Luedtke, Jr., et al. The rejection is maintained.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***CLOSING REMARKS***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashwin Mehta whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M. to 5:30 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell can be reached on 703-308-4310. The fax phone numbers for the organization where this application or proceeding is assigned is 703-305-3014. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ashwin Mehta  
July 30, 2001

DAVID T. FOX  
PRIMARY EXAMINER  
GROUP 180-1638

*David T. Fox*